



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,074	11/07/2001	Koichi Hayashizaki	2001_1573A	4721
513 7590 12/09/2003 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER AHMED, SHAMIM	
			ART UNIT 1765	PAPER NUMBER

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,074

Applicant(s)

HAYASHIZAKI, KOICHI

Examiner

Shamim Ahmed

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7 have been considered but are moot upon the cancellation of the claims 1-7. The new claims 8-19 are rejected in view of a new ground(s) of rejection.

Applicants argue that the JP-7-164728 does not teach that the transfer layer is placed on a plastic plastic key top body after the etching of the metallization layer. In response, examiner states that the argument is not persuasive because the JP-7-164728 clearly teaches that the metallization layer (4) is etched and thereafter, transferring the transfer layer including the etched metal layer, second transparent layer and the first transparent layer (see figures 2 and 4).

Applicants also argue that JP-7-164728 does not teach that the lower concealment layer (2) is a transparent layer.

In response to the argument, examiner states that the concealment layer is made by dispersing carbon black in a resin binder such as acrylic resin, which is transparent in nature (see the paragraph 0019).

Therefore, the concealment layer is transparent in nature at least at certain degree because the layer includes transparent resin material.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8-12,14-16,18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 7-164728.

JP-7-164728 discloses a process for using a transfer substrate for plastic moulding products such as key tops of personal computers, wherein a metallic layer (4) is formed on the transfer substrate (6) (see paragraphs 0001 and 0021 in the translated version and figure 2).

JP-7-164728 also discloses forming transparent printed or transparent coloring layer including character, a sign and a pattern (31,32) on the metallic layer (see paragraph 0021 and 0032 of the translated version).

JP-7-164728 further discloses that after etching the metallic layer, the transfer substrate is placed on a plastic-molding article, which corresponds a plastic key top body for transferring the transparent printed layer and metallic layer onto the plastic molding article (see the paragraphs 0024 to 0026 of the translated version and figures 4-6).

JP-7-164728 inherently teaches that the portion of the metallic layer is removed, which is not masked or covered by the transparent printed layer by etching in order to expose a lower transparent coloring layer in the shape of a pattern such as a character, a sign and a pattern (see the paragraph 0027 of the translated version).

As to claim 9, JP-7-164728 teaches that forming a second transparent layer (2) prior to the deposition of the metal layer (see the paragraph 0019 and 0027 of the translated version).

As to claim 10, JP-7-164728 teaches that a parting agent layer or release layer is formed on the transfer substrate before forming the second or lower transparent layer and the metallic layer (see the paragraph 0018 of the translated version).

As to claims 12 and 16, JP-7-164728 teaches that forming an adhesive layer (5) of suitable property including transparency of the layer (see the paragraph 0022 of the translated version).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-7-164728 in view of Lee et al (5,387,495).

The JP-7-164728 discussed above in the paragraph 3 and also teaches that the metal layer is etched by laser etching (see the paragraph 0021).

JP-7-164728 fails to teach that wet etching including alkaline or acidic aqueous solution performs the etching.

However, in a method of etching metal, Zhang et al teach that either the laser or conventional wet etching can be used (col.4, lines 447-49 and lines 62-63).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of claimed invention to combine Lee et al's teaching into JP-7-164728's process because both the laser etching and wet etching are functionally equivalent as taught by Lee et al.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shamim Ahmed whose telephone number is (703) 305-1929. The examiner can normally be reached on M-Thu (7:00-5:30) Every Friday Off.

Application/Control Number: 09/986,074

Page 6

Art Unit: 1765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine G Norton can be reached on (703) 305-2667. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Shamim Ahmed
Examiner
Art Unit 1765

SA
November 22, 2003


ROBERT KUNEMUND
PRIMARY EXAMINER